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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,878	03/24/2004	Michael Martindale	MAR-2.001	6644

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GANZ LAW, P.C.
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EXAMINER

HOEKSTRA, JEFFREY GERBEN

ART UNIT	PAPER NUMBER
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3736

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/808,878

Applicant(s)

MARTINDALE, MICHAEL

Examiner

Jeffrey G. Hoekstra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,9-11,14,19 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 11,14,19,21-23 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,9,10,24-27 and 29-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/11/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice of Amendment

1. In response to the amendment filed on 11/20/2006, amended claim(s) 10 and 24; canceled claim(s) 1-5, 7-8, 12-13, 15-18, and 20; withdrawn claim(s) 11, 14, 19, 21-23, and 28; and new claim(s) 29-34 is/are acknowledged. The current rejections of the claim(s) 6, 9, 10, and 24-27 is/are *withdrawn*. The following new and reiterated grounds of rejection are set forth:

Claim Objections

2. Claim 6 is objected to because of the following informalities: the positive recitation of "a first region" and "a second region" appears to duplicate the structure as recited in independent claim 24 (e.g. "a first position" and "a second position") and/or may be indefinite for failing to distinctly claim what Applicant regards as the invention.

Appropriate correction is required.

3. Claim 9 is objected to because of the following informalities: the positive recitation of "the template includes an alignment guide *is* adapted to align" appears to contain a typographical error and/or may be indefinite as grammatically incorrect.

Appropriate correction is required.

4. Claim 10 is objected to because of the following informalities: the positive recitation of "the foot" in at least line 1 appears to lack antecedent basis and may render the claim indefinite. Appropriate correction is required.

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5. Claim 24 is objected to because of the following informalities: the positive recitation of "attachable to anatomy" appears to lack antecedent basis and may render the claim indefinite. Appropriate correction is required.

6. Claims 24, 25, 26, and 27 are objected to because of the following informalities: the positive recitation of "the talus" appears to lack antecedent basis and may render the claims indefinite. Appropriate correction is required.

7. Claim 26 is objected to because of the following informalities: the positive recitations of "the observed motion" and "the displacement" in lines 2-3 appear to lack antecedent basis and may render the claim indefinite. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 6, 9, 10, and 24-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Graf et al. (US 4,662,079, hereinafter Graf) as broadly as *structurally* claimed.

10. For claims 10, 24, and 26, Graf discloses a foot assessment device, comprising:

- a means for observing the motion of the talus from a static position comprising a marker (elements 74, 76, and 91) attachable to an anatomy of a test subject and capable of performing the following functions: adapted for application to a talar-head region of the foot, allowing for observation of the motion of the talus from a first

position to a second position, and adapted to aid visual inspection of the foot in a first or second position (abstract); and

- a means to determine from the observed motion the displacement of the talus relative to an axis of the foot comprising a template (elements 81 and 86) capable of performing the following functions (as best seen in Figure 4A) (column 9 lines 42-65): adapted to align the foot in the first or second position, to determine an angular displacement of the foot, and adapted to allow a determination of an alignment of the foot on the template in a neutral position used as a reference point for determining a degree of supination or pronation (abstract).

11. For claim 6, Graf discloses a foot assessment device, wherein said template further comprising: a first region capable of being adapted to represent a first amount of pronation of the foot in the second position and a second region capable of being adapted to represent a second amount of pronation of the foot in the second position (as best seen in Figure 4A) (column 9 lines 42-65).

12. For claim 9, Graf discloses a foot assessment device, wherein said template includes an alignment guide (elements 81 and 86) is capable of being adapted to align the foot in a subtalar-joint-neutral position.

13. For claims 25 and 27, Graf discloses a foot assessment device, wherein a light source (73) is used as the means for observing the motion of the talus.

14. For claims 29-32, Graf discloses a foot assessment device, wherein the neutral position is capable of corresponding to a subtalar joint neutral position and/or a foot's transmalleolar axis.

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15. For claims 33-34, Graf discloses a foot assessment device, wherein said template comprises a first plate (81) adjustable with respect to a second plate (86) capable of facilitating placement of a foot in a neutral position used as reference point for determining a degree of supination or pronation.

Response to Arguments

16. Applicant's arguments filed 11/20/2006 have been fully considered but they are not persuasive. Applicant argues Graf does not disclose, teach, or suggest each and every element of the claimed invention, specifically Graf "does not teach or suggest any means in a template on which a foot is positioned for a determination of a neutral position". The Examiner disagrees, maintains the anticipatory rejection of the claims under Graf, and notes the following:

17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a "means in a template on which a foot is positioned for a determination of a neutral position") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. In response to applicant's argument that Graf does not disclose, teach, or suggest a "template being adapted to allow a determination of an alignment of the foot on the template in a neutral position used as a reference point for determining a degree of supination or pronation", a recitation of the intended use of the claimed invention

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must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571) 272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571) 272-4726. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JH

